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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,524	03/14/2001	David Harold Berry	CSA 2 0114	4510

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EXAMINER

SAETHER, FLEMMING

ART UNIT PAPER NUMBER

3679

DATE MAILED: 01/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/808,524

Applicant(s)

BERRY ET AL.

Examiner

Flemming Saether

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-13, 15, 16, 18-20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-13, 15, 16, 18-20 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The dependency of claim 7 is unclear since the claim from which it depends has been canceled.

***Claim Rejections - 35 USC § 103***

Claims 1, 3, 4, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caldwell (US 4,403,895) in view of Hamamoto (US 5,694,666) and further in view of Harris (US 3,225,641). Caldwell discloses a fastening peg (10) comprising a conical piercing point (32), a helical flange (36) spiraling radially and circumferentially from the point, a shoulder (40) axially spaced from the flange and, locking assembly (48). The helical flange terminated in a radial edge and as can be seen in Fig. 3, is spaced 360° from where the helical flange begins at the point. Caldwell further teaches a method of piercing and rotating to advance the fastener into the opening and then axially securing the fastener to an opening (28). Caldwell does not disclose the fastener in combination with a weatherseal. Hamamoto discloses a fastener (1) in combination with a weatherseal in order to secure it to a vehicle body. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to use the fastener of Caldwell in combination with weatherseal as disclosed in

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Hamamoto in order that the fastener could be used to optimally attach a weatherseal.

Hamamoto further discloses to provide a locking assembly with locking arms (8). At the time the invention was made, it would have been obvious for one of ordinary skill in the art to provide the locking assembly of modified Caldwell with locking arms as disclosed in Hamamoto such that it would be easier to fit the locking assembly into an opening.

Caldwell as modified by Hamamoto fails to disclose the dimension between the flange and shoulder to be greater than a thickness of the weatherseal. Harris discloses a weatherseal assembly comprising a fastening peg having a flange (195) and a shoulder (196) where a dimension there between is shown to be greater than the thickness of a weatherseal surface (at 2). At the time the invention was made, it would have been obvious for one of ordinary skill in the art to dimension the shoulder and flange in modified Caldwell to be greater than a thickness of the weatherseal surface as disclosed in Harris in order to facilitate insertion of fastening peg into the weatherseal. Indeed, where the dimension of the flange and shoulder are greater than the thickness of the weatherseal surface there would be less frictional forces to be overcome.

Claims 11, 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caldwell (US 4,403,895) in view of Hamamoto (US 5,694,666). Caldwell discloses a fastening peg (10) comprising a conical piercing point (32), a helical flange (36) spiraling radially and circumferentially from the point, a shoulder (40) axially spaced from the flange and, locking assembly (48). The helical flange terminated in a radial edge and as can be seen in Fig. 3, is spaced 360° from where the helical flange begins

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at the point. Caldwell further teaches a method of piercing and rotating to advance the fastener into the opening and then axially securing the fastener to an opening (28).

Caldwell does not disclose the fastener in combination with a weatherseal. Hamamoto discloses a fastener (1) in combination with a weatherseal in order to secure it to a

vehicle body. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to use the fastener of Caldwell in combination with

weatherseal as disclosed in Hamamoto in order that the fastener could be used to optimally attach a weatherseal. Hamamoto further discloses to provide a locking

assembly with locking arms (8). At the time the invention was made, it would have been obvious for one of ordinary skill in the art to provide the locking assembly of modified

Caldwell with locking arms as disclosed in Hamamoto such that it would be easier to fit the locking assembly into an opening.

Claims 2, 7-9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caldwell in view of Hamamoto and Harris as applied to claims 1 above, or Caldwell in view of Hamamoto as applied to claims 11 and 12, and further in view of Schmidt.

Schmidt teaches a threaded fastener wherein the threads begin at a location spaced from the point and to provide a thread to a pointed nose (Fig. 15). At the time the invention was made, it would have been obvious for one of ordinary skill in the art to provide the pointed nose of modified Caldwell space the beginning of the helical flange from the point and to provide the nose with the a thread as taught in Schmid in order to facilitate the piercing of the substrate as disclosed therein.

Claims 16, 18-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caldwell (US 4,403,895) in view of Hamamoto (US 5,694,666) and further in view of Grenell (US 4,271,554). As discussed above, the combination of Caldwell and Hamamoto discloses a self-piercing fastener used in combination with a weatherseal. Grenell teaches that it is known to self-pierce a substrate by initially drilling at a first rotational velocity while then advancing the threads at a second, slower, rotational velocity (column 7, line 17-22). At the time the invention was made, it would have been obvious for one of ordinary skill in the art to pierce and advance the fastener of modified Caldwell in a manner as disclosed in Grenell because as noted in Grenell such is well known for efficient assembly.

***In response to Applicant's Remarks:***

The allowance of claims 1-4 and 7-10 had to be withdrawn in view of the newly found prior art to Harris. The examiner regrets any inconvenience.

Contrary to applicant's remarks, the subject matter of claim 14 was not allowable. The omission of "14" in the rejection was simply a typographical error. In reviewing the text of the rejection, it was quickly apparent that the subject matter of claim 14 was included therein. Applicant's attention is directed to page 3, line 5-6 of the previous office action where it states, "Hamamoto further discloses to provide a locking assembly with locking arms (8)" which clearly corresponds to the "first and second flexible arms"

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forming claim 14. The error being on the part of the office would necessitate this action being made non-final but, the issue has been made moot by the new rejection to claims 1-4 and 7-10 necessitated by the reference to Harris.

Applicant's arguments regarding Stokes have been rendered moot in view of the new grounds of rejection applied to claims 16, 18-20 and 22.

### ***Allowable Subject Matter***

To be clear and to avoid any confusion as with the previous office action, there are no claims currently allowable.

### ***Conclusion***

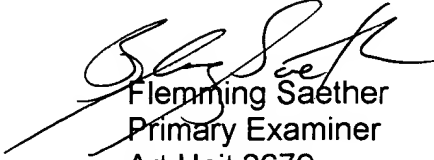
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Flemming Saether whose telephone number is 703-308-0182. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on 703-308-1159.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



Flemming Saether  
Primary Examiner  
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